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REMARKS

The Examiner has rejected the pending claims of the application based upon 35 U.S.C. §112 first paragraph as failing to comply with the written description requirement.

In *In re Smith* (1973), 481 F.2d 910, 178 USPQ 620 (CCPA 1973), the CCPA noted that the description requirement can arise in any of three different contexts.

“Satisfaction of the description requirement insures that subject matter presented in the form of a claim subsequent to the filing date of the application was sufficiently disclosed at the time of filing so that the prima facie date of invention can fairly be held to be the filing date of the application. This concept applies whether the case factually arises out of an assertion of entitlement to the filing date of a previously filed application under §120 or arises in the interference context wherein the issue is support for a count in the specification of one or more of the parties or arises in an ex parte case involving a single application, but where the claim at issue was filed subsequent to the filing of the application. Where the claim is an original claim, the underlying concept of insuring disclosure as of the filing date is satisfied; and the description requirement has likewise been held to be satisfied.”

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Claim 1 in the present case has been amended. However, the amendment to claim 1 is primarily that of moving the limitations of claim 2 to claim 1. Under such situations, the possession by the inventors of the claimed invention is clear because of the existence of claim 2 as originally filed. The Examiner has not pointed out any part of claim 1 that is not supported by the specification (and claims) as originally filed. The Examiner confuses the first paragraph of §112 written description requirement with the enablement requirement. This confusion is clear when the Examiner again states:

"the disclosure does not appear to describe *how* the changes are actually calculated." (emphasis added).

The Examiner errs when stating that a failure to explain how the invention is done is a failure to provide a written description under §112, first paragraph, especially when the scope of originally filed claim 2 is considered to prove what the inventors possessed at the time of filing. Additionally, the Examiner has improperly summarily disregarded the factual information provided in the earlier filed declaration of Gregory T. Young.

The Examiner summarily dismisses Mr. Young's declaration by characterizing it as an attempt to interpret and explain the disclosure. The declarant, Mr. Young is a person having ordinary skill in the art and as such, he provided factual information about enablement of the present invention. It is improper for the Examiner to summarily disregard the facts provided by Mr. Young.

The Applicants believe that the claims as written are enabled, (see the declaration of Gregory T. Young) and are compliant with the written description

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requirement of §112, first paragraph, (see the content of claim 2 as originally filed). The Examiner is reminded that the specification of a patent is directed to a person having ordinary skill in the art who understands the prior art. It is not necessary for the application itself to describe every detail of the invention if those details are understood by persons skilled in the art, such as Mr. Young. The content of the prior art is presumed to be disclosed in the application and delineated in the drawings.

In *Webster Loom Co. v. Higgins* (USSC 1881) 105 U.S. (15 Otto.) at 582-86, the US Supreme Court upheld the Webster patent on an improvement in looms for weaving pile fabrics. The defendant contended that the specification "was insufficient in its description of the invention sought to be patented, and failed to show any means of applying it to existing looms" and that "independent invention would have to be exercised to make it a practical working apparatus as an attachment of such looms." The Court rejected the contention and commented at length on the rule that the specification need be enabling only to persons skilled in the art.

"The specification proceeds to describe the mechanism of the invention by a description and reference to drawings all which would be incomprehensible to a person unacquainted with looms for weaving pile fabrics, but very plain to one who understood their construction and operation at the date of the patent. A person skilled in the art of constructing or using such looms in their most advanced and improved form,

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such as those known as the Bigelow loom and the Weild loom and having one actually before him or in his mind would readily appreciate the meaning of the terms and the character of the improvement described."

"When an astronomer reports that a comet is to be seen with the telescope in the constellation of Auriga, in so many hours and minutes of right ascension, it is all Greek to the unskilled in science; but other astronomers will instantly direct their telescopes to the very point in the heavens where the stranger has made his entrance into our system. They understand the language of their brother scientist. If a mechanical engineer invents an improvement on any of the appendages of a steam-engine he is not obliged, in order to make himself understood, to describe the engine, nor the particular appendage to which the improvement refers, nor its mode of connection with the principle machine. These are already familiar to others skilled in that kind of machinery. He may begin at the point where his invention begins, and describe what he has made that is new, and what it replaces of the old. That which is common and well known is as if it were written out in the patent and delineated in the drawings." (emphasis added).

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The Applicants respectfully request reconsideration of the rejection of the pending claims. Notification of allowance is believed to now be appropriate, and early notification of the same would be appreciated.

Respectfully submitted,

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